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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,009	08/09/2001	Pankaj Vinubhai Shah	A01098A	4173

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05/21/2003

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EXAMINER

GOFF II, JOHN L

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 05/21/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,009

Applicant(s)

SHAH, PANKAJ VINUBHAI

Examiner

John L. Goff

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 5. 6) ☐ Other:

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 2/25/02 (Paper no. 4) fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered. U.S. Patent 4,814,373 was attached to paper no. 4, but it was not listed in a list of art. It has been considered and cited on the attached PTO-892.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-3 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Graham (U.S. Patent 6,356,700).

Graham is directed to a method for forming a moisture reactive hot melt adhesive. Graham teaches a first step of reacting a polyol (e.g. a polyester polyol) and a polyisocyanate in an NCO:OH ratio of 0.7-1.4 to form a hydroxyl-functional prepolymer. Graham teaches a second step of admixing the prepolymer with additional polyol (e.g. crystalline polyester polyol) and polyisocyanate in an NCO:OH ratio of 1.2-3 followed by reacting the admixture to form a moisture reactive hot melt adhesive. Graham teaches the moisture reactive hot melt adhesive is used to bond a variety of substrates (Column 1, lines 21-29 and Column 2, lines 7-9, 14-16, 44-46, and 49-53 and Column 3, lines 29-34, 38-46, 51-53, and 59-62 and Column 5, lines 11-21). It is noted Graham does not specifically recite in the second step admixing the prepolymer and additional polyol in a 9/1 to 1/9 weight ratio. However, Graham teaches the prepolymer content in the adhesive is 30-60%, and the additional polyol content is 5-70%. Graham further shows an example wherein the weight ratio of prepolymer to additional polyol is about 2/1. In any event it would have been obvious to one of ordinary skill in the art at the time the invention was made to admix the prepolymer and additional polyol within the specified ranges in order to provide a useful reactive hot melt in Graham as the ordinary artisan would have been expected to experimentally determine the optimum ratio for a given property and adhesive being manufactured.

Claim Rejections - 35 USC § 103

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graham as applied above in paragraph 4, and further in view of Anderson et al. (U.S. Patent 5,939,499).

Graham as applied above teaches all of the limitations in claim 4 except for a specific teaching of a method for applying the moisture reactive hot melt adhesive. However, as noted above Graham teaches the moisture reactive hot melt adhesive is used to bond a variety of substrates. One of ordinary skill in the art at the time the invention was made would have readily appreciated applying the moisture reactive hot melt adhesive taught by Graham using the general technique in the art of applying the adhesive in a hot state to a substrate in the presence of moisture and cooling the adhesive after application of a second substrate as this technique is well known as shown for example by Anderson et al.

Anderson et al. are directed to moisture reactive hot melt adhesives. Anderson et al. teach a method for applying the adhesive comprising applying the adhesive to a first substrate at a temperature of 95 to 175 °C, contacting a second substrate to the applied adhesive, and cooling the adhesive. Anderson et al. teach the moisture reactive adhesive is cured by moisture in the atmosphere or by adding reactive compounds having free active hydrogens to the bond line (Column 7, lines 41-63).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **703-305-7481**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

JL Goff

John L. Goff
May 16, 2003

JH Aftergut

JEFF H. AFTERGUT
PRIMARY EXAMINER
GROUP 1000